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DAVID P GORDON
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STAMFORD, CT 06905

EXAMINER

NGUYEN, BINH AN DUC

ART UNIT	PAPER NUMBER
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3713

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 18

Application Number: 09/186,856
Filing Date: November 05, 1998
Appellant(s): GORDON ET AL.

Thomas A. Gallagher
For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 17, 2002.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The appellant's statement in the brief that the rejected claims do not stand or fall together is agreed.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,405,151	Naka et al.	04-1995
5,080,377	Stamper et al.	01-1992
5,354,063	Curchod	10-1994
Re.35,314	Logg	08-1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-18, 20, and 21 are rejected under 35 U.S.C. 103 (a) as being obvious by Naka et al. (5,405,151) in view of Stamper et al. (5,080,377) or Curchod (5,354,063). Paper No.13, pages 2-5, paragraph numeral 4.

Claim 19 is rejected under 35 U.S.C. 103 (a) as being obvious by Naka et al. (5,405,151) and Stamper et al. (5,080,377) or Curchod (5,354,063), and further in view of Logg (Re 35,314). Paper No.13, page 5, paragraph numeral 5.

(11) Response to Argument

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At the onset it is noted that appellants have chosen to argue the references individually, rather than in combination.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The examiner, nonetheless, respond to each of appellants' points to further show why appellants' arguments are not persuasive.

Response to Appellants's Arguments on rejected claims 1-18, 20, and 21 under 35 U.S.C 103(a) as being obvious by Naka et al. (5,405,151) in view of Stamper et al. (5,080,377) or Curchod (5,354,063) (Section III, page 12, line 1 to page 25, line 5 of Appellants' Brief).

Response to Section III (a) regarding rejected claim 1 (page 12, line 4 to page 15, line 2 of Appellants' Brief)

The appellants' arguments of Section III (a) regarding four points that: (a) neither of the secondary references teaches split screen means which is responsive to player location, (b) Stamper et al. is not a multiplayer game, (c) Curchod is non-analogous art, and (d) there is no incentive to combine the references (page 12, line 8 to page 15, line 2 of Appellants' Brief) are not persuasive.

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(a) Appellants' arguments to the first point that both of the secondary references link the split screen mode to game token location rather than player location (page 12, line 24 to page 13, line 7 of Appellants' Brief) are not persuasive.

In Stamper et al. and Curchod, the pin ball and golf ball are the player's "character," equivalent to applicants' controlled "character." The only difference is appellants arbitrary naming for the sake of argument.

(b) Appellants' arguments to the second point that Stamper et al. is not a multiplayer game as claimed in claim 1 or as disclosed in Naka et al. (page 13, lines 8-13 of Appellants' Brief) are not persuasive.

Stamper et al. is not relied upon for such a teaching, the base reference Naka et al. is multiplayer. Stamper et al. has been relied upon for teaching automatic split screen based upon distance between elements in a video game. Here again, appellants present a piecemeal argument to a single reference rather than considering the combination applied.

(c) Appellants' arguments to the third point that a golf simulator is not analogous to a video game and that none of the classes and subclasses in the classification or field of search in Naka et al. can be found in the classification or field of search in Curchod (page 13, lines 14-20 of Appellants' Brief) are not persuasive.

Clearly, Curchod is a game utilizing video technology. The mere fact that the USPTO classification is so finely segregated that two videogame's patents could issue in different subclasses with different searches does not negate the teachings contained within the references themselves. One searching the videogame area and aware of

Naka et al. clearly would consider all relevant patents dealing with graphics processing and split screen techniques, including both Stamper et al. and Curchod.

(d) Appellants' arguments to the fourth point that no incentive for attempting a combination of Naka et al. with either of the secondary references can be found in the references or in the art general (page 13, line 21 to page 15, line 2 of Appellants' Brief) are not persuasive.

In response to appellants' argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as generally well known to one of ordinary skill in the video game art, creating a better game with exciting graphics is key to success of the game. Such is a driving force in this highly competitive industry. The fact that appellants may have noted a similar motivation does not, alone, establish the examiner applying any improper use of hindsight. Motivation is not proprietary.

The appellants' invention concerns enhancement of graphics processing and issues of displaying graphics, therefore, the graphics processing references taught by Naka et al. and Stamper et al. are relevant since Naka et al. teaches players acting cooperatively and Stamper et al. teaches a video display system having split screen

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means being responsive to playing field location means such that during a game when the token and the game control component (flippers) are within a preset range, the separate portions of the graphical display for the two are merged into a single portion of the graphical display, and when the two components' game locations (of playing token and control component) are outside the preset range, the graphical display for those two components is split into separate portions, Figures 2b and 2c. Meanwhile, Curchod teaches a double position golf simulator with split screen means being responsive to player location means such that when two players' game locations are within a preset range (when their golf balls are near the same hole), the separate portions of the graphical display for the two players are merged into a single portion of the graphical display, and when the two players' game locations are outside the preset range (when the golf balls are near different holes), the graphical display for the two players is split into separate portions (2:63-66, 3:51-53, 17:3-44, and 19:53-20:9).

Response to Section III (b) regarding rejected claims 2, 3, 4, 5, and 20 (page 15, line 3 to page 16, line 5 of Appellants' Brief):

(b) Appellants' arguments of none of the art used to reject the claims requires that the players act jointly or cooperatively at certain points in the game are not persuasive.

Respectfully, appellants' argument is not commensurate in scope with appellants' claim language. Naka et al. teaches a system and method for controlling the motion of two game characters via first user input device and second user input device,

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comprising: joint action means for requiring at least two players to act jointly with each other at certain points in the game (2:5-39). Naka et al. further requires two players to act jointly with each other at certain points in said game when one player drops behind (Naka et al., 20:35-40), or when exchanging by teleport box in the competitive mode (Naka et al.'s Figs. 41, 42, 44, and 45). Appellants' argued "cooperative" mode is much narrower in scope than appellants' claimed "joint action."

Moreover, all of the responses made above with reference to claim 1 regarding the lack of incentive to combine the references also apply to these claims.

Response to Section III (c) regarding rejected claims 4 and 15 (page 16, line 6 to page 17, line 31 of Appellants' Brief):

(c) Appellants' arguments regarding the art cited in the rejection does not teach a requirement of joint or cooperative action on the part of the players in which the players act jointly at separate locations in split screen are not persuasive. Appellants' arguments to the "cooperative mode" are not well taken and appear to cloud the issue. Claims 4 and 15 require players to act jointly at separate locations in the split screen mode. This is met by Naka et al.'s competitive mode and in particular the "teleport box" swap previously noted. Joint action is required in that neither player can refuse to swap, i.e., both players must participate. The triggers for the swaps are located at separate locations in the split screen mode.

Moreover, all of the responses made above with reference to claim 1 regarding the lack of incentive to combine the references also apply to these claims.

Response to Section III (d) regarding rejected claims 6, 9, 12, 17, and 20

(page 18, lines 1-24 of Appellants' Brief):

(d) Appellants' arguments regarding the art cited in the rejection does not teach the limitation of no player can complete the game unless all players complete the game are not persuasive.

The examiner respectfully disagree. If players are in Naka et al.'s cooperative mode, it necessarily follows that player one cannot complete the game without player two completing the game, thus, encompassing appellants' claim language. Clearly, Naka et al. encompasses the claimed attribute.

Moreover, all of the responses made above with reference to claim 1 regarding the lack of incentive to combine the references also apply to these claims.

Response to Section III (e) regarding rejected claims 7 and 16 (page 19, line 1 to page 20, line 15 of Appellants' Brief):

(e) Appellants' arguments regarding Naka et al. does not automatically switch from single screen to split screen and vice versa based on player location or based on any game criteria are not persuasive. Naka et al. clearly does teach switching between single screen modes and split screen modes. See "Mode Switching" (columns 21:44-22:45). What he lacks is a clear teaching that this switching occurs based upon a preset range as required by claims 1-6, which has been shown as obvious to one of ordinary skill in the art at the time of the invention after consideration of the Stamper et al.'s and Curchod' teachings. Claims 7 and 16 merely require a split screen when characters act

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individually and a merged screen when characters act jointly or at "some points" during the game. This feature is shown in Naka alone. As anticipation is the epitome of obviousness, the rejection of these claims under 35 U.S.C. 103 is proper and should be affirmed.

Moreover, all of the responses made above with reference to claim 1 regarding the lack of incentive to combine the references also apply to these claims.

Response to Section III (f) regarding rejected claims 8, 11 and 13 (page 20, line 16 to page 21, line 13 of Appellants' Brief):

(f) Appellants' arguments regarding none of the references require different joint actions at different points in the game are not persuasive. As noted above, Naka et al. possessed two types of "joint action," one in the "cooperative mode" with merged screen and one with position exchange during split screen. Clearly, these are different joint actions at different points of the game.

Moreover, all of the responses made above with reference to claim 1 regarding the lack of incentive to combine the references also apply to these claims.

Response to Section III (g) regarding rejected claim 10 (page 21, lines 14 -24 of Appellants' Brief):

(g) Appellants' arguments regarding neither Stamper et al. nor Curchod requires or even allows joint action among players are not persuasive. As discussed

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above, appellants argued "cooperative mode" is not commensurate in scope with his claimed "joint action." The argued feature is clearly shown in Naka et al. alone.

Moreover, all of the responses made above with reference to claim 1 regarding the lack of incentive to combine the references also apply to claim 10.

Response to Section III (h) regarding rejected claim 14 (page 22, lines 1 –22 of Appellants' Brief):

(h) Appellants' arguments regarding the cited art does not require a split screen for some points in the game and merged screen for other points in the game are not persuasive. Naka et al., for example, at least splits at the point of the game for competition, and merges at the point of the game where a player falls behind. These points occur at different scenes or at parts of the game which require different actions. Appellants appears to be arguing claim language which is much more restrictive than actually claimed.

Moreover, all of the responses made above with reference to claim 1 regarding the lack of incentive to combine the references also apply to claim 14.

Response to Section III (i) regarding rejected claim 18 (page 23, line 1 to page 24, line 2 of Appellants' Brief):

(i) Appellants' arguments regarding claim 18 which "requires cooperative action among or between players, where the kind of cooperative action includes at least one cooperative action selected from the group consisting of:

both players operating on the same object at the same time, each player operating on a different object at the same time,

one player operating on a first object before the other player operates on said first object,

one player accomplishing one task while the other player accomplishes another task,

one player accomplishing a first task before the other player accomplishes a second task.” are not persuasive.

First, it is noted the claim in question does not require a plurality of different kinds of joint actions, but “at least one” cooperative action. The cooperative following of player two in the cooperative mode clearly meets the limitation “one player operating on a first object before the other player operates on said first object.” Nothing in appellants’ claim language precludes imitation from meeting the claimed “operates.”

Response to Section III (j) regarding rejected claims 1, 7, and 10 (page 24, line 3 to page 25, line 5 of Appellants’ Brief):

(j) Appellants’ arguments regarding the limitation of requiring that the game be “an adventure game” are not persuasive.

Appellants’ point are not well taken for at least two reasons. First, the examiner is attaching four articles which offer definitions of an “adventure” game which contradict that which appellants argued and support that which the examiner asserts. Second, by appellants’ own definition, Naka et al. clearly is an adventure game, thus meeting the

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claims preamble environmental descriptor. On page 12 of the instant specification, lines 7-12, appellants define an adventure game to be "As used herein, 'adventure game' means a game where the players must traverse different landscapes, find things, solve puzzles, and perform tasks." Reading Naka et al. at column 22, lines 65-68, one finds the Naka et al. environment to include "Two players race through a playfield (traverse landscapes), surmount obstacles (solve puzzles), gather "magical rings" for example (find things), and slay enemies (perform tasks). Clearly Naka et al. meets appellants' definition of an adventure game.

Moreover, all of the responses made above with reference to claim 1 regarding the lack of incentive to combine the references also apply to these claims.

Response to Section IV regarding rejected claim 19 (page 25, line 6 to page 26, line 6 of Appellants' Brief):

Appellants' arguments regarding claim 19 over the limitations of "requiring at least one of the following cooperative actions: holding a door for a player, handing a tool to a player, giving an item to a player, helping a player lift an object" (page 25, lines 10-15 of Appellants' Brief) are not convincing.

Logg clearly teach players sharing limited resources (11:64-65), and further, acting cooperatively to defense each other from monster and overcome challenges (11:54-12:20).

Response to Section V (Appellants' Brief, page 26, line 6 to page 27, line 8).

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Appellants' statement of claims 1, 7, 10 and 18 were effectively allowed over Logg and Naka et al. in Paper No. 4 is not true or accurate.

No agreement on patentable claims has been set forth in Paper #4 (Interview Summary). As of record, referring to Paper No. 4, it was agreed that Naka (Naka et al.) did not anticipate the split screen feature. The limitation of split screen feature, however, has been rejected in view of Stamper et al. (see Papers No. 6, 8, and 11). Clearly, no agreement as to patentability of any claim has ever been set in the prosecution history.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Furthermore, Appellants' arguments are not commensurate the scope of the claims which centralizes the graphics processing of video game.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

Binh-An D. Nguyen
Examiner
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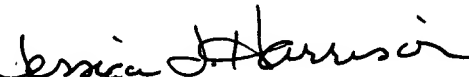
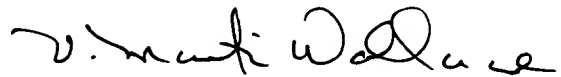
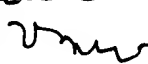
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September 4, 2002

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